

REMARKS

The Examiner is thanked for the courtesy of the telephone discussion regarding Applicant's previous submission of an amendment after final, not entered and now submitted herein as an amendment accompanying a "Request for Continued Examination." Support for the previously offered amendment can be found in paragraph [0050] of the application. Additionally, the independent claims have been amended to explicitly identify the "stretchable" nature of the enclosure cover; support for this amendment can be found at paragraph [0046]. Entry of the amendments and favorable consideration are respectfully requested.

In the final rejection mailed April 22, 2004, claims 1-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nopper et al.* (U.S. Patent 5,021,638) in view of *King-DeBaun* (U.S. Patent 6,285,299) for the reasons set forth in the communication.

Applicant submits the present amendments to the independent claims to further distinguish over the references, advance prosecution and permit the application to be passed to allowance. The amendments incorporate features of the claimed cover that are recited in the application and that have been relied on in arguments previously presented to the Examiner. It is again noted that Applicant has previously distinguished the art in view of the touch or feel characteristics of the invention. In this regard, the Examiner's attention is invited to Applicant's response dated December 17, 2003, page 12, second full paragraph, in which Applicant states: ". . . a cover of the type claimed, having the additional feature(s) of universal applicability, ease of application and ease of removal for preventing the transmission of disease, and the maintenance of features suitable to the use of this particular technology,

e.g., maintaining the touch and feel of the keyboard array beneath the cover."

Importantly, the limitations further distinguish over the references, particularly *Nopper et al.*, relied on by the Examiner in rejecting the claims. While *Nopper et al.* discusses the need for improved touch and feel in a keyboard cover, the means by which *Nopper et al.* achieve their result is necessarily different from that of the present invention because *Nopper et al.* requires the use of a cover that is molded to each specific keyboard configuration to which it is applied, and it sets forth required construction features in an attempt to minimize the loss of touch and feel through its cover. In this regard, the Examiner's attention is invited to column 4, lines 15-22 of *Nopper et al.*:

"In order to prevent the loss of the "touch" or "feel" when utilizing a keyboard array covered with a membrane of the present invention it is necessary that the sidewalls 30 and 32 not be permitted to extend all the way into the valley 33 between the keys of the keyboard assembly."

This requirement is again set forth in claim 1 of *Nopper et al.*, column 5, lines 37-42. These restrictions are necessitated by the fact that the *Nopper et al.* cover is molded to each and every keyboard key configuration to which it is applied.

In contrast, as set forth in claim 1 herein, the cover of the present invention "comprises a thin, elastomeric and substantially transparent membrane in proximate contact with said keys" and "does not correspond to the depressions or elevations of a specific keyboard array." (Emphasis added.)

In order to rely on *Nopper et al.*, the Examiner must ignore its specific teachings regarding molding its surface to conform to each specific keyboard to which it is applied. In

doing so, a specific inventive feature of *Nopper et al.* is eliminated. Consequently, according to the standards set forth in MPEP 2143, a *prima facie* case of obviousness cannot be established because it is improper to suggest a modification to *Nopper et al.* that will render it unsatisfactory for its intended purpose and change its principle of operation. Clearly, if the molded depressions and elevations of *Nopper et al.* were to be eliminated, it would no longer be satisfactory for its intended purpose since the *Nopper et al.* construction is shown to result in a cover with a fixed surface configuration and the elimination of molded-in depressions and elevations would make it unable to function as described.

Regarding claim 19, the Examiner states that the operative steps of the claim "merely recited the purpose of a process or the intended use of the keyboard cover to avoid the transmission of disease." It is respectfully suggested that this aspect of the rejection is moot in view of the further amendment to claim 19 by incorporation of the preamble language into the body of the claim. Additionally, the claim recites objective process steps consistent with the requirements for a method claim. Thus, withdrawal of this aspect of the rejection in view of the amendment is respectfully requested.

Finally, with regard to claim 19, it is noted that the Examiner refers in several instances to a lack of "evidence to support the claim." The Examiner's attention is invited to MPEP 2107.02 regarding Procedural Considerations Related to Rejections for Lack of Utility," which bears on the issue of "evidence." As noted in the cited MPEP section, an asserted utility creates a presumption of utility. Furthermore, the initial burden is on the Office to establish a *prima facie* case and provide evidentiary support showing that the invention of claim 19 lacks utility and to provide a sufficient evidentiary basis for the factual assumptions relied on in establishing such

a showing. In other words, "the PTO must do more than merely question operability - it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." See *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975). In section V of the cited section of the MPEP, it is noted that in appropriate situations the Office may require an applicant to substantiate an asserted utility. However, an appropriate situation is considered to be "When the operativeness of any process would be deemed to be unlikely by one of ordinary skill in the art." See *In re Pottier*, 376 F.2d 328, 330, 153 USPQ 407, 408 (CCPA 1967). In the present situation, since the Examiner asserts that the stated utility would be obvious, i.e., a "method of avoiding the transmission of disease carrying organisms between at least one user and other users of a keyboard," it would be inconsistent to also suggest that the asserted utility is unlikely or incredible and requires independent proof. Withdrawal of this aspect of the rejection is respectfully requested.

In conclusion, it is respectfully submitted that the present amendments further limit and distinguish the claims of the present invention and such amendments also incorporate features that were previously presented to the Examiner as argument.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 09/823,430

Docket No.: COSTEL 3.0-001

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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